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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,572	01/15/2004	Ji Wang	3000-000001/US	4524
30593 HARNESS, DI	7590 11/01/2007 CKEY & PIERCE, P.L.C.	·	EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

*		Application No.	Applicant(s)		
		10/757,572	WANG ET AL.		
	Office Action Summary	Examiner	Art Unit		
		Lin Liu	2145		
Period fo	The MAILING DATE of this communication app or Reply	ears on the cover sheet with the c	correspondence address		
WHIC - Exter after - If NC - Failu Any	ORTENED STATUTORY PERIOD FOR REPLY CHEVER IS LONGER, FROM THE MAILING DANSIONS of time may be available under the provisions of 37 CFR 1.13 SIX (6) MONTHS from the mailing date of this communication. Operiod for reply is specified above, the maximum statutory period were to reply within the set or extended period for reply will, by statute, reply received by the Office later than three months after the mailing ed patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tir will apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. nely filed the mailing date of this communication. (D (35 U.S.C. § 133).		
Status		•			
1)⊠	Responsive to communication(s) filed on 15 Ja	nuary 2004.			
• —	This action is FINAL. 2b)⊠ This action is non-final.				
3)					
	closed in accordance with the practice under E	x parte Quayle, 1935 C.D. 11, 4	53 O.G. 213.		
Disposit	ion of Claims				
5)□ 6)⊠ 7)□	Claim(s) <u>1-20</u> is/are pending in the application. 4a) Of the above claim(s) is/are withdraw Claim(s) is/are allowed. Claim(s) <u>1-20</u> is/are rejected. Claim(s) is/are objected to. Claim(s) are subject to restriction and/or	vn from consideration.			
Applicat	ion Papers				
10)⊠	The specification is objected to by the Examine The drawing(s) filed on <u>15 January 2004</u> is/are: Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct The oath or declaration is objected to by the Ex	a)⊠ accepted or b)⊡ objected drawing(s) be held in abeyance. Se ion is required if the drawing(s) is ob	e 37 CFR 1.85(a). ojected to. See 37 CFR 1.121(d).		
Priority (under 35 U.S.C. § 119				
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 					
Attachmer	nt(c)				
1) Notice 2) Notice 3) Infor	ce of References Cited (PTO-892) ce of Draftsperson's Patent Drawing Review (PTO-948) mation Disclosure Statement(s) (PTO/SB/08) er No(s)/Mail Date 01/15/2004.	4) Interview Summary Paper No(s)/Mail D 5) Notice of Informal F 6) Other:	ate		

DETAILED ACTION

1. This office action is responsive to communications filed on 01/15/2004.

Claims 1-20 are pending and have been examined.

Claim Rejections - 35 USC § 112

- 2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
 - The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
- 3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "substantially unnoticeable" recited in claims 1 and 12 is a relative term, which renders the claims indefinite. The term "substantially unnoticeable" is not explicitly defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. All of the other dependent claims are rejected under the same rationale.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 12-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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With regard to claim 12, the instant claim is drawn towards an apparatus with means for downloading Internet advertisement and a player for playing said Internet advertisement, wherein the means for downloading and the player for playing Internet advertisement could be implemented in software alone. Claims directed toward software alone refer to functional descriptive material, which is per se non-statutory. Claims 13-20 are rejected under the same rationale.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/970397. Although the conflicting claims are not identical, they are

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not patentably distinct from each other because the additional limitation "presenting, in a container" as recited in the pending application # 10/970397 is an obvious variation of the claims in the present application. In specific, the Internet advertisement of the present application is presented to the user in a browser web page, wherein the browser web page is equivalent to a container.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 and 12 of present application	Claims 1 and 15 of pending application #: 10/970397	
Claim 1. A method of downloading Internet	Claim 1. A method of providing Internet	
advertisement, comprising steps of:	contents, comprising steps of:	
downloading an Internet	downloading said Internet contents	
advertisement in a manner substantially	in a manner substantially unnoticeable to a	
unnoticeable to a user who browses a web	user who browses a web page;	
page;	presenting, in a container , said	
after said Internet advertisement is	Internet contents to said user, after said	
completely downloaded, playing said	Internet contents are completely	
Internet advertisement to said user.	downloaded.	
Claim 12. An apparatus for downloading	Claim 15. An apparatus for providing	
Internet advertisement, comprising:	Internet contents, comprising:	
means for downloading an Internet	means for downloading Internet	
advertisement in a manner substantially	contents in a manner substantially	
unnoticeable to a user who browses a web	unnoticeable to a user who browses a web	

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page;

a player for playing said Internet advertisement to said user after said Internet advertisement is completely downloaded.

page;

means for presenting said Internet contents to said user in a container after said Internet contents are completely downloaded.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- 9. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Landsman et al. (PGPUB: US 2003/0028565 A1).

With respect to **claim 1**, Landsman teaches a method of downloading Internet advertisement, comprising steps of:

downloading an Internet advertisement in a manner substantially unnoticeable to a user who browses a web page (Landsman: abstract, page 9, paragraph 88, and page 10, paragraphs 96-97, noted that the internet ads are transparently downloaded into client's browser cache.);

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after said Internet advertisement is completely downloaded, playing said Internet advertisement to said user (Landsman: abstract, page 5, paragraphs 36-37, and page 10, paragraphs 96-97, noted that the internet ads are play through the browser.).

With respect to **claim 2,** Landsman teaches the method according to claim 1, further comprising steps of:

opening a separate window independent of said web page, said Internet advertisement being downloaded in said separate window (Landsman, page 12, paragraph 110 and pages 17-18, paragraphs 159-160, noted that pop-up ad window);

causing said separate window emerge from behind all windows in front of it after said Internet advertisement is completely downloaded (Landsman, page 12, paragraph 110 and pages 17-18, paragraphs 159-160, noted that pop-up ad window); and

playing said Internet advertisement in said separate window (Landsman, page 12, paragraph 110 and pages 17-18, paragraphs 159-160, noted that pop-up ad window).

With respect to **claim 3**, Landsman teaches the method according to claim 2, wherein said separate window is selected from a group consisting of a dialog box, a popup window (Landsman, page 12, paragraph 110 and pages 17-18, paragraphs 159-160, noted that pop-up ad window), a banner, a floating window, and an inline frame.

With respect to **claim 4,** Landsman teaches the method according to claim 1, wherein said step of downloading an Internet advertisement comprises steps of:

downloading a first part of said Internet advertisement into a browser cache (Landsman: page 11, paragraph 101);

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calculating downloading bandwidth (Landsman: page 12, paragraph 108, noted the full communication bandwidth);

identifying current connection which is either a wide band connection or a narrow band connection (Landsman: page 12, paragraph 108, noted the full communication bandwidth is substantially the same as wide band connection);

downloading a following part of said Internet advertisement in a way appropriate to said current connection (Landsman: page 11, paragraph 101, noted the second portion of advertising tag).

With respect to **claim 5**, Landsman teaches the method according to claim 4, wherein said steps of calculating downloading bandwidth, identifying current connection, and downloading a following part of said Internet advertisement are repeated until said Internet advertisement is completely downloaded (Landsman: page 16, paragraph 151, noted that the transition sensor applet checks for the occurrence of a play Ad event in a loop.).

With respect to **claim 6**, Landsman teaches the method according to claim 5, further comprising steps of:

opening a separate window independent of said web page after said Internet advertisement is completely downloaded (Landsman, page 12, paragraph 110 and pages 17-18, paragraphs 159-160, noted that pop-up ad window); and

playing said Internet advertisement in said separate window (Landsman, page 12, paragraph 110 and pages 17-18, paragraphs 159-160).

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With respect to **claim 7,** Landsman teaches the method according to claim 6, wherein said separate window is selected from a group consisting of a dialog box, a popup window (Landsman, page 12, paragraph 110 and pages 17-18, paragraphs 159-160, noted that pop-up ad window), a banner, a floating window, and an inline frame.

With respect to **claim 8**, Landsman teaches the method according to claim 5, wherein said step of identifying current connection comprises steps of:

if said downloading bandwidth is greater than a wide band threshold, identifying said current connection as a wide band connection; and

if said downloading bandwidth is less than a narrow band threshold, identifying said current connection as a narrow band connection (Landsman: page 3, paragraph 17, noted that the downloading bandwidth is less than a pre-established threshold.)

With respect to **claim 9**, Landsman teaches the method according to claim 5, wherein said step of downloading a following part of said Internet advertisement comprises steps of:

downloading said Internet advertisement for a second predetermined period if said current connection is identified as a wide band connection; and

downloading a predetermined number of bytes of said Internet advertisement if said current connection is identified as a narrow band connection (Landsman: page 3, paragraph 17, noted that the polite agent downloads ad files.).

With respect to **claim 10**, Landsman teaches the method according to claim 9, wherein said step of downloading a predetermined number of bytes of said Internet

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advertisement is suspended for a first predetermined period if said downloading bandwidth is less than an idle threshold (Landsman: page 19, paragraphs 176-177).

With respect to **claim 11,** Landsman teaches the method according to claim 5, wherein said steps of downloading a first part of said Internet advertisement, calculating downloading bandwidth, identifying current connection, and downloading a following part of said Internet advertisement are implemented in a Java applet embedded in said web page (Landsman, page 6, paragraph 44, page 7, paragraph 48, page 11, paragraph 101).

In regard to **claims 12-20**, the limitations of these claims are substantially the same as those in claims 1-11. Therefore the same rationale for rejecting claims 1-11 is used to reject claims 12-20. By this rationale **claims 12-20** are rejected.

Claim Rejections - 35 USC § 103

- 10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 11. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 - 1. Determining the scope and contents of the prior art.
 - 2. Ascertaining the differences between the prior art and the claims at issue.
 - 3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tafla (PGPUB: US 2001/0056370) in view of Rakavy et al. (PGPUB: US 2002/0010775 A1).

With respect to **claim 1,** Tafla teaches a method of downloading Internet advertisement, comprising steps of:

downloading an Internet advertisement to a user who browses a web page (Tafla: abstract, figures 3-5, page 3, paragraphs 44-45, noted that an animated advertisement is downloaded to client's computer.);

after said Internet advertisement is completely downloaded, playing said Internet advertisement to said user (Tafla: figures 1-2, page 3, paragraphs 44-45, noted that the animated advertisement is played in a web page layer).

However, Tafla does not explicitly teach a method of downloading an Internet advertisement in a manner unnoticeable to a user.

In the same field of endeavor, Rakavy teaches a method of downloading an Internet advertisement in a manner unnoticeable to a user (Rakavy: abstract, page 2, paragraph 16 and page 7, paragraph 119, noted that the advertisement is transparently downloaded to client's computer).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of downloading an Internet advertisement in a transparent manner to the user as taught by Rakavy in Tafla's

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invention in order to perform the communication task in the background without imposing a noticeable overhead on the user (Rakavy: page 7, paragraph 119).

With respect to **claim 2,** Tafla teaches the method according to claim 1, further comprising steps of:

opening a separate window independent of said web page, said Internet advertisement being downloaded in said separate window (Tafla: figures 1-2, page 3, paragraph 45, noted the web page layer.);

causing said separate window emerge from behind all windows in front of it after said Internet advertisement is completely downloaded (Tafla: figures 1-2, page 3, paragraph 45, noted that the web page layer is superimposed over the web page); and playing said Internet advertisement in said separate window (Tafla: figures 1-2).

With respect to **claim 3,** Tafla teaches the method according to claim 2, wherein said separate window is selected from a group consisting of a dialog box, a popup window, a banner, a floating window (Tafla: figures 1-2, page 3, paragraph 43), and an inline frame.

With respect to **claim 4**, Tafla teaches the method according to claim 1, wherein said step of downloading an Internet advertisement comprises steps of:

downloading a first part of said Internet advertisement into a browser cache (Tafla: page 4, paragraph 49, noted the animated object is downloaded);

downloading a following part of said Internet advertisement in a way appropriate to said current connection (Rakavy: page 4, paragraph 53).

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However, Tafla does not explicitly teach a method of calculating downloading bandwidth; and identifying current connection which is either a wide band connection or a narrow band connection.

In the same field of endeavor, Rakavy teaches a method of calculating downloading bandwidth; and identifying current connection which is either a wide band connection or a narrow band connection (Rakavy: fig. 6, page 7, paragraph 119, noted that the agent determines the load threshold and current line utilization.).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of calculating downloading bandwidth; and identifying current connection which is either a wide band connection or a narrow band connection as taught by Rakavy in Tafla's invention in order to properly regulate the advertisement data transfer and impose minimum overhead on the system to prevent any communication degradation for the user (Rakavy, page 8, paragraph 126).

With respect to **claim 5**, Tafla teaches all the claimed limitations, except that he does not explicitly teach a method of repeatedly performing calculating downloading bandwidth, identifying current connection, and downloading a following part of Internet advertisement until the Internet advertisement is completely downloaded.

In the same field of endeavor, Rakavy teaches a method of a method of repeatedly performing calculating downloading bandwidth, identifying current connection, and downloading a following part of Internet advertisement until the Internet advertisement is completely downloaded (Rakavy, fig. 6, page 8, paragraphs 124-129).

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of repeatedly performing calculating downloading bandwidth, identifying current connection, and downloading a following part of Internet advertisement until the Internet advertisement is completely downloaded as taught by Rakavy in Tafla's invention in order to properly regulate the advertisement data transfer and impose minimum overhead on the system to prevent any communication degradation for the user (Rakavy, page 8, paragraph 126).

With respect to **claim 6**, Tafla teaches the method according to claim 5, further comprising steps of:

opening a separate window independent of said web page after said Internet advertisement is completely downloaded (Tafla: figures 1-2, page 3, paragraph 45, noted the web page layer.); and

playing said Internet advertisement in said separate window (Tafla: figures 1-2, page 3, paragraph 45).

With respect to **claim 7,** Tafla teaches the method according to claim 6, wherein said separate window is selected from a group consisting of a dialog box, a popup window, a banner, a floating window (Tafla: figures 1-2, paragraph 43), and an inline frame.

With respect to **claim 8**, Tafla teaches all the claimed limitations except that he does not explicitly teach a method of if a downloading bandwidth is greater than a wide band threshold, identifying a current connection as a wide band connection; and if a

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downloading bandwidth is less than a narrow band threshold, identifying a current connection as a narrow band connection.

In the same field of endeavor, Rakavy teaches a method of if a downloading bandwidth is less than a narrow band threshold, identifying a current connection as a narrow band connection (Rakavy, fig. 6, block 44, page 8, paragraph 127).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of comparing the bandwidth and identifying the connection taught by Rakavy in Tafla's invention in order to properly regulate the advertisement data transfer and impose minimum overhead on the system to prevent any communication degradation for the user (Rakavy, page 8, paragraph 126).

With respect to **claim 9**, Tafla teaches all the claimed limitations except that he does not explicitly teach a method of downloading an Internet advertisement for a second predetermined period if a current connection is identified as a wide band connection; and downloading a predetermined number of bytes of an Internet advertisement if a current connection is identified as a narrow band connection.

In the same field of endeavor, Rakavy teaches a downloading a predetermined number of bytes of a Internet advertisement if a current connection is identified as a narrow band connection (Rakavy, fig. 6, page 8, paragraphs 127-129).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of downloading a predetermined number of bytes of said Internet advertisement if said current connection is identified as

a narrow band connection taught by Rakavy in Tafla's invention in order to properly regulate the advertisement data transfer and impose minimum overhead on the system to prevent any communication degradation for the user (Rakavy, page 8, paragraph 126).

With respect to **claim 10,** Tafla teaches all the claimed limitations except that he does not explicitly teach a method of downloading a predetermined number of bytes of an Internet advertisement is suspended for a first predetermined period if said downloading bandwidth is less than an idle threshold.

In the same field of endeavor, Rakavy teaches a method of a method of downloading a predetermined number of bytes of said Internet advertisement is suspended for a first predetermined period if said downloading bandwidth is less than an idle threshold (Rakavy, fig. 6, page 8, paragraphs 120, 127-19).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of downloading a predetermined number of bytes of said Internet advertisement is suspended for a first predetermined period if said downloading bandwidth is less than an idle threshold as taught by Rakavy in Tafla's invention in order to properly regulate the advertisement data transfer and impose minimum overhead on the system to prevent any communication degradation for the user (Rakavy, page 8, paragraph 126).

With respect to **claim 11,** Tafla teaches the method according to claim 5, wherein said steps of downloading a first part of said Internet advertisement, and downloading a

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following part of said Internet advertisement are implemented in a Java applet embedded in said web page (Tafla: page 4, paragraph 51).

However, Tafla does not explicitly teach a method of implementing a method of calculating downloading bandwidth and identifying current connection in a Java applet.

In the same field of endeavor, Rakavy teaches a method of implementing a method of calculating downloading bandwidth and identifying current connection in a Java applet (Rakavy, page 6, paragraph 101).

In regard to **claims 12-20**, the limitations of these claims are substantially the same as those in claims 1-11. Therefore the same rationale for rejecting claims 1-11 is used to reject claims 12-20. By this rationale **claims 12-20** are rejected.

Conclusion

- 13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
 - Ellis et al. (PGPUB: US 2004/0015608 A1) discloses a method for dynamically incorporating advertising content into multimedia environments.
 - Wang et al. (PGPUB: US 2002/0175935 A1) discloses a method of loading ads in a web page and displaying a web page.
 - Gabbard et al. (Patent no.: US 6,205,432 B1) discloses a background advertising system.
 - Barsade et al. (PGPUB: US 2002/0169670 A1) discloses a network banner advertisement system.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lin Liu whose telephone number is (571) 270-1447. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SUPERVISORY PATENT EXAMINER